

REMARKS

In view of the foregoing amendments and the following remarks, reconsideration and allowance are respectfully requested.

Claims 2, 4-28, and 30-31 were pending at the time of this Office Action, with Claims 5, 17, and 27 the independent claims. Claims 5, 17, and 27 are amended herein. No new matter has been added. Support for the amended claims is found throughout the specification as filed. In particular, support for the amendment to Claim 5 is found in the second and third full paragraphs on page 13 of the specification as filed. Support for the amendments to claims 17 and 27 is found in the fourth paragraph beginning on page 22, as well as the four full paragraphs beginning on page 23.

Claim 1 stands objected to for alleged informalities. Applicants submit that claim 1 was cancelled by a previously submitted amendment, and that this objection is therefore moot.

Claims 5, 17, and 27 stand rejected under 35 U.S.C. § 112 as allegedly failing to comply with the enablement requirement and as allegedly indefinite. Claims 2 and 4-15 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over U.S. Patent No. 5,080,364 to Seidman in view of U.S. Patent No. 6,370,514 to Messner and in view of "Official Notice." Claim 16 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Seidman in view of Messner and further in view of United States Published Patent Application No. 2002/0178071 A1, to Walker. Claims 17-28 and 30-31 stand rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Giftcertificates.com web pages in view of "Official Notice." Claim 21 stands rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Giftcertificates.com in view of Walker.

35 U.S.C. § 112 Rejections

The Office Action rejects Claims 5, 12, and 27 under 35 U.S.C. § 112 as allegedly not enabled. The Office Action bases this conclusion partially on claim language that does not appear in the amended claims. Applicants submit that with the benefit of the specification one skilled in the art would understand how to make and use the present invention as it is defined in

the amended claims. The Office Action further remarks that "the understanding of the applicant's invention is impeded significantly by the confusing and contradictory definitions through out the specification...." With respect to this point, applicants submit that the language of the amended claims is clear in light of the specification when read in its entirety. Furthermore, applicants respectfully note that definitions of many claim terms were provided in the specification, particularly from page 7, second paragraph, through page 10, first paragraph.

The Office Action also rejects Claims 5, 17, and 27 for alleged indefiniteness. This rejection is based on a number of phrases that do not appear in the amended claims. The rejection has been traversed. Applicants respectfully submit that the claims, as amended, are definite and satisfy the requirements of 35 U.S.C. § 112.

The rejections based on 35 U.S.C. § 112 have been traversed. The rejections should be withdrawn and the claims allowed.

35 U.S.C. § 103 Rejections

1. Claims 2 and 4-16

The amended independent Claim 5 is patentable at least because Seidman, Messner, and the observations listed as "Official Notice" fail to teach or suggest each and every feature of the claim. Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either explicitly or implicitly in the references themselves or in the knowledge generally available to one of ordinary skill in the art (MPEP 2143).

In particular, Seidman, Messner, and "Official Notice" fail to teach or disclose any system in which an authorization code is associated with at least one characteristic of a purchaser. Even assuming that the Office Action is correct in its statement that an authorization code of Seidman "is assisted with at least one characteristic that is recorded for tracking purposes," the disclosure of Seidman reports that the codes are present on tokens or as "identification code symbols on packages of goods." (Abstract). There is no indication in Seidman that the authorization code is associated with a characteristic of the purchaser.

Similarly, there is no such teaching in Messner or in anything that would provide "Official Notice."

Moreover, even if the references could be combined as suggested, the mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). There is no suggestion in Seidman or Messner for their combination, and neither is a proper reference under 35 U.S.C. § 103.

Messner teaches away from Seidman, and combining those references to make a rejection under 35 U.S.C. § 103 is not permitted. It is improper to combine references where the references teach away from their combination. *In re Grasselli*, 713 F.2d 731, 743, 218 USPQ 769, 779 (Fed. Cir. 1983). A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention. *W.L. Gore & Associates, Inc. v. Garlock, Inc.*, 721 F.2d 1540, 220 USPQ 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984) (MPEP 2141).

A stated object of Seidman is to "provide[] a gaming method including the steps of automatically reading codes on tokens presented by patrons *at a redemption location within an establishment.*" (Seidman: Abstract, emphasis added). Seidman repeatedly stresses the importance of having a consumer enter an establishment and stay within an establishment. (Seidman: Col. 1, lines 14-17, 31-33, and 55-57). Messner, however, reports that its method is structured to encourage online transactions, not transactions at "brick and mortar" stores. (Messner: Col. 2, lines 62-63). Even if the cited publications taught or suggested all of the elements of the claims, one skilled in the art would not have been motivated to combine them, because they teach away from their combination.

In addition to teaching away from their combination, both Seidman and Messner individually teach away from the invention. Seidman reports a system in which a seller of goods sells goods to a purchaser, who provides a code to a user, who then uses the code at the purchaser's place of business. This is different from the claims of the instant invention. Messner reports the use of "centralized processing" that "frees participating merchants from having to

develop the in-house technical expertise necessary to administer such a [voucher] system." (Messner: Col. 3, lines 1-3). This is dissimilar to the instant invention, in which the online product is provided by the system. Applicants further incorporate by reference in this response the arguments in their previous response regarding the inapplicability of Messner to any claims of the invention. In particular, applicants assert that Messner is not a proper reference at to amended Claim 5 because amended Claim 5 recites "wherein at a time said certificate is provided to said user, information associated with said user is not provided to said system providing an online product." In contrast, Messner teaches providing information associated with the user, such as the user's personal information (Messner: Col. 4, lines 15-21; Col. 8, lines 47-51; Col. 9, lines 27-41; Claim 5).

Claims 2, 4, and 6-16 are allowable at least because they each depend upon an allowable base claim, Claim 5. These dependent claims are further allowable for reciting patentable subject matter in their own right.

For at least these reasons, the Applicants respectfully request that the rejections under 35 U.S.C. 103 be withdrawn and Claims 2 and 4-16 be put in condition for allowance.

2. Claims 17-20, 21-28, and 30-31

Independent claims 17 and 21 are patentable over the Giftcertificates.com web pages included with the Office Action. As an initial matter, Applicants contend that the Giftcertificates.com web pages are not a competent reference under 35 U.S.C. § 103(a). "If the publication does not include a publication date (or retrieval date), it cannot be relied upon as prior art under 35 U.S.C. § 102(a) or (b)...." (MPEP 2128). Inability to serve as a § 102 reference precludes use as a § 103 reference.

The Giftcertificates.com web pages provided with the Office Action do not include a publication date. Their retrieval date, June 23, 2005, is apparent from both the date in the bottom right corner of the printout. Furthermore, this appears to match the date that the pages were generated, as indicated by the url, <<http://web.archive.org/web/20050623104215/...>>. (Emphasis added). This date is long after the priority date of the instant application. Furthermore, the web pages include at least three further indicia demonstrating that they are

dated after the January 21, 2001 priority date of the instant application. First, the pages are marked "© 1996-2005, GiftCertificates.com." It is unlikely that a web page from September 2000 would bear a 2005 copyright notice. Second, page 4 of the provided pages states, "SuperCertificates issued after June 30, 2004 never expire." Use of such a legend on a September 2000 web page is unlikely. Third, "SUPERCERTIFICATE" is denoted a registered trademark in the web pages provided with the Office Action. The United States Patent and Trademark Office trademark search website indicates that "SUPERCERTIFICATE" was not placed on the Supplemental Register until August 2, 2001, and was not placed on the Primary Register until March 5, 2002. Designation of the term as a registered trademark prior to those dates would have been inappropriate and therefore unlikely.

The Giftcertificates.com web pages provided with the Office Action do not have a sufficiently early date to act as a reference against the instant application. Applicants therefore request that the rejection of Claims 17-20, 21-28, and 30-31 be withdrawn and the claims be put in condition for allowance.

Finally, applicants note that even if the Giftcertificates.com web pages were a competent reference (which they are not), they do not include all of the limitations of the rejected claims and will not support a rejection under § 103(a). Independent Claims 17 and 27 both contain the limitation of "receiving payment for a plurality of certificates." The Giftcertificates.com web pages do not teach payment for a plurality of certificates; even when combined with the "Official Notice" as suggested in the Office Action, the most that can be said is that Giftcertificates.com receives a plurality of payments for a series of individual certificates. Because Giftcertificates.com does not include all of the limitations of the invention, the rejection should be withdrawn, and Claims 17-20, 21-28, and 30-31 should be allowed.

CONCLUSION

It is believed that all of the pending claims have been addressed in this response. However, failure to address a specific rejection, issue, or comment, does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above are not intended to be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment.

Claims 2, 4-28, and 30-31 are in condition for allowance, and a notice to that effect is respectfully solicited.

No fee is believed to be due at this time. Please apply any other charges or credits to Deposit Account No. 02-4553, in the name of Buchanan Ingersoll PC.

Respectfully submitted,



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